

APR 10 2006

FACSIMILE TRANSMISSION

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DATE: April 10, 2006

To:

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Commissioner for Patents	USPTO	571-273-8300	

FROM: Rudolf O. Siegesmund

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FILE NO.: AIBM.018	NUMBER OF PAGES, INCLUDING COVER: 27
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MESSAGE:

Application No. 09/731,651
Applicant: Malcolm et al.
Title: Method & Apparatus for Filling Out Electronic Forms
Examiner: Burge
Art Group: 2178
Docket No.: AUS920000655US1

Attached are the following:

1. Appeal Brief;
2. Transmittal Form; and
3. Fee Transmittal

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APR 10 2006

PTO/SB/17 (12-04v2)

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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL
For FY 2005**☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

Complete if Known

Application Number	09/731,651
Filing Date	12/07/2000
First Named Inventor	Malcolm
Examiner Name	Burge
Art Unit	2178
Attorney Docket No.	AUS920000655US1

METHOD OF PAYMENT (check all that apply)
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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)
Each independent claim over 3 (including Reissues)
Multiple dependent claims

Fee (\$)	Small Entity Fee (\$)
50	25
200	100
360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 20 or HP =	0	x	=	0
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HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 3 or HP =	0	x	=	0
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HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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- 100 =	0	/ 50 =		(round up to a whole number) x	=	
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4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief**Fees Paid (\$)**

500.00

SUBMITTED BY

Signature	<u>Rudolf O. Siegemund</u>	Registration No. (Attorney/Agent)	37,720	Telephone	214-461-4050
Name (Print/Type)	Rudolf O. Siegemund	Date	April 10, 2006		

This collection of information is required by 37 CFR 1.138. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/21 (09-04)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/731,651
Filing Date	12/07/2000
First Named Inventor	Malcolm
Art Unit	2178
Examiner Name	Burge
Attorney Docket Number	AUS920000655US1

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.62 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks _____		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Gordon & Rees, LLP		
Signature	<i>Rudolf O. Siegesmund</i>		
Printed name	Rudolf O. Siegesmund		
Date	April 10, 2006	Reg. No.	37,720

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This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BOARD OF PATENT APPEALS & INTERFERENCES

In re Malcolm,

Appellant,

For: Method and Apparatus for Filling Out
Electronic Forms

Filed: 12/07/2000

) Serial No. 09/731,651
)
) Docket No. AUS920000655US1
)
) Art Unit 2178
)
) Examiner Burge
)
)
)

Brief in Support of Appeal

April 10, 2006

Commissioner for Patents
P.O. Box 1450
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To the Honorable Commissioner for Patents:

The examiner of the pending application identified above has finally rejected the appellant's claims set forth therein, and the appellant has timely submitted a Notice of Appeal to the Board of Patent Appeals and Interferences. The appellant submits the following brief to support the appeal to the Board.

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Attorney Docket No. AUS920000655US1

I. REAL PARTY IN INTEREST

The real party in interest in the present application is International Business Machines Corporation.

II. RELATED APPEALS & INTERFERENCES

The appellant, the appellant's legal representative, nor the assignee has any knowledge of any application, patent, appeal, interference, or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

The application included 30 claims. Claims 1-9, 11-13, 15, 16, 18-20, 22-24, and 26-30 are pending. Claims 10, 14, 17, 21 and 25 have been cancelled. No claims have been allowed. The examiner has rejected all pending claims.

IV. STATUS OF AMENDMENTS

All of the amendments have been entered in the present case.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The essence of the claimed subject matter comprises a "standard compliant database," a "standard compliant form" and a set of rules for combining the standard complaint database with the standard complaint form so that when a user creates a standard complaint database, and a requester provides a user compliant form, the form will be automatically populated in accordance with the rules. (4:6-16)

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Independent claim 1 recites a method for inserting data into an electronic form having at least one field that is compliant with a standard. The method comprises: (1) providing a database having at least one field that is compliant with the standard, wherein at least one compliant database field may have a plurality of field values (4:9-11; 7:6-7; 11:1-9); (2) providing a set of rules that select one field value from each compliant database field having a plurality of field values (4:13-16; 1:9-12); (3) applying the set of rules to select one field value from each compliant database field having a plurality of field values (7:6-10; 9:11-12); (4) matching each compliant database field with the corresponding compliant form field (9:10-13, 16-20); and (5) inserting each selected field value into the corresponding compliant form field (9:10-20); wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database (5:11-6:3); and whereby a completed form is created (9:20).

Independent claim 12 recites a computer program encoded in a computer-readable medium and operable on a processor to inserting data into an electronic form having at least one field that is compliant with a standard. The computer program comprises: (1) means for retrieving the electronic form from a network (8:14-9:1); (2) means for creating a database having at least one field that is compliant with the standard, wherein at least one compliant database field may have a plurality of field values (4:9-11; 7:6-7; 11:1-9); (3) means for creating a set of rules operable to select one field value from each compliant database field having a plurality of field values 4:13-16; 11: 9-12); (4) means for applying the set of rules to select one field value from each compliant database field having a plurality of field values (7:6-10; 9:11-12); (5) means for matching each compliant database field with the corresponding compliant form field (9:10-13; 9:16-20);

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and (6) means for inserting each selected field value into the corresponding compliant form field (9:10-20); wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database (5:7-8); and whereby the computer program product creates a completed form.

Independent claim 22 recites a communication system for filling out an electronic form having at least one field that is compliant with a standard. The communication system comprises: (1) a first computer (8:12-13); (2) a second computer coupled to the first computer through a communications medium (8:7-8); (3) a first storage device coupled to the first computer (8:7-8), the first storage device comprising a database having at least one field that is compliant with the standard, wherein at least one compliant database field may have a plurality of field values (4:9-11; 7:6-7; 11:1-9), and (4) a set of rules that select one field value from each compliant database field having a plurality of field values (4:13-16; 11:9-12); (5) a second storage device coupled to the second computer, the second storage device containing the electronic form; and a controller coupled to the first storage device operable to transfer the electronic form from the second storage device to the first storage device through the communications medium (8:7-9:1); (6) apply the set of rules to select one field value from each compliant database field having a plurality of field values; (4:13-16; 11:9-12); (7) match each compliant database field with the corresponding compliant form field (9:10-13; 9:16-20); and (8) insert each selected field value into the corresponding compliant form field (9:10-20); wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database (5:11-6:3); and whereby a completed electronic form is produced.

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VI. ISSUES ON APPEAL**A. Claim Objections**

1. Whether the examiner's objection to claims 1, 12 and 22's use of the word "may" should be sustained.

B. Claim Rejections – 35 U.S.C. § 103

1. Does the prior art upon which the examiner relies teach or suggest all of the limitations of claims 1-9, 11-13, 15, 16, 18-20, 22-24, and 26-30, including a standard which is a protocol extension that specifies the files that may be used in the electronic form and in the database?

2. Has the examiner provided substantial evidence of a motivation to modify or combine the teachings of the prior art in regard to claims 28 and 30?

3. Has the examiner impermissibly evaluated the appellant's claims "part by part," using the appellant's claims as a "roadmap to find the prior art components of claims 1-9, 11-13, 15, 16, 18-20, 22-24, and 26-30.

VII. ARGUMENT**A. Claim Objections.**

The claims recite "at least one compliant database field may have a plurality of field values" (claim 1, line 4) and "fields that may be used" (claim 1, lines 11). The use of the term "may" is by way of describing the capability of the database and the fields, and not by way of limitation. The independent claims contain specific limitations regarding the database and fields that are not permissive. For example, claim 1 recites,

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inter alia, “applying the set of rules to select one filed value from each compliant database field having a plurality of field values.”

B. Claim Rejections – 35 U.S.C. § 103

1. Applicable law.

An applicant’s claimed invention may be unpatentable under 35 U.S.C. § 103 if it would have been “obvious” to a person of ordinary skill in the art to modify or combine the prior art in order to meet the claims, even if a single reference does not anticipate the claimed invention. *See* 35 U.S.C.S. § 103(a); *Beckson Marine v. Nfm, Inc.*, 292 F.3d 718, 727 (Fed. Cir. 2002) (stating that “obviousness may render a claimed invention invalid where the record contains a suggestion or motivation to modify the prior art teaching to obtain the claimed invention,” even if the prior art does not “reach expressly each limitation exactly”); *Hartness Int’l, Inc. v. Simplimatic Eng’g Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987) (“the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed”). “Obviousness” is a legal conclusion based on underlying findings of fact.¹ *In re Peterson*, 315 F.3d 1325, 1328 (Fed. Cir. 2003). The underlying factual inquiry includes determining “the scope and content of the prior art;” ascertaining the “differences between the prior art and the claims at issue;” and resolving “the level of ordinary skill in the pertinent art.” *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001).

¹ Legal conclusions of obviousness are reviewed de novo, while the underlying factual conclusions are reviewed for substantial evidence. *In re Peterson*, 315 F.3d 1325, 1328 (Fed. Cir. 2003).

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The examiner, though, carries the initial burden of establishing a *prima facie* case of obviousness before rejecting a claimed invention under 35 U.S.C. § 103. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *In re Wertheim*, 541 F.2d 257, 263 & 265 (C.C.P.A. 1976); MPEP § 2141, 2142, 706.02(j); *see also* 35 U.S.C.S. § 132. To establish *prima facie* obviousness of a claimed invention, the examiner must demonstrate with substantial evidence that all the claim limitations are taught or suggested by the prior art. *See, e.g., In re Zurko*, 258 F.3d at 1384-85 (holding invention was not obviousness because prior art failed to teach single element); *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1986) (finding that prior art was deficient in at least one element – the claimed invention could not have been obvious without motivation to add element); *accord* MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974)).

But most, if not all, inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d at 1357). “Thus, every element of a claimed invention may often be found in the prior art” and the examiner must consider the claimed invention as a whole. *Id.* at 1369-70; *accord* MPEP § 2141.02. “[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *Kotzab*, 217 F.3d at 1370. The examiner may not evaluate the invention “part by part,” using the invention as a “roadmap to find its prior art components.” *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Accordingly, there must be some motivation, suggestion or teaching of the desirability of making the specific combination to establish obviousness based on a

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combination of the elements disclosed in the prior art. *Princeton Biochemicals*, 411 F.3d at 1337; *Kotzab*, 217 F.3d at 1370; accord *MPEP* § 2143.01. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *Kotzab*, 217 F.3d at 1370. The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves, in the nature of the problem to be solved, or in the knowledge generally available to one of ordinary skill in the art. *Beckson Marine*, 292 F.3d at 728 (citing *Rouffet*, 149 F.3d at 1357). It is the duty of the examiner to identify the source of the motivation, and to explain why the combination of the teachings is proper. *Rouffet*, 149 F.3d at 1356-57; *In re Fitch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification"). Hindsight reconstruction is impermissible. *Id.*

2. The examiner has failed to establish *prima facie* obviousness because the prior art cited by the examiner does not teach all of the claimed limitations.

The prior art cited by the examiner does not teach a standard which is a protocol extension that specifies the fields that may be used in the electronic form and in the database. Specifically, the examiner cites Maxwell, col. 14:62 to col. 15:32, to disclose "wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database." (11/9/05 office action, page 3.) But Maxwell discloses a "form completion program" using a registry containing multiple fields. Specifically, the referenced section of Maxwell states:

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In one embodiment of the invention, the form completion program uses a registry with the operating system (OS) to assure proper execution. The registry contains multiple fields. Each field contains information that may be utilized by the form completion program during execution. An example of the kinds of fields that may be placed in the registry follows.

Field Name	Description
InstallPath	Contains the path of the installed program
UpdateFile	Contains the name and path to copy to be deleted
Last User	Contains the name of the last user
Coordinate X	Contains the horizontal coordinate (in pixel) of the program window
Coordinate Y	contains the vertical coordinates (in pixel), of the program window
Server URL	Contains URL(s) where update routine should check for a new version of the program

When the form completion program is installed, a directory structure is created that contains files used by the form completion program during execution. This directory contains the form completion program and two sub-directories: "user" and "data". The "user" sub-directory contains as many sub-directories as there are users. Each sub-directory contains one file called by the login name of the user, followed by the extension ".dat". This file contains encrypted data about the user (e.g. address, credit card information, electronic money, etc. ...). The "data" sub-directory contains general information utilized by the form completion program during execution. For example, graphical images that represent various kinds of data, web site information, and other information useful to the form completion program is placed in the "data" sub-directory. The information placed in the "data" sub-directory is organized in a tree of one or more additional sub-directories.

Maxwell does not disclose the use of a form or a database that is compliant with a "standard," as that term is properly construed. Moreover, Maxwell is dependent on installation of a form completion program, and on the form completion program's interaction with a registry of an operating system. Applicant's invention is independent of an operating system registry.

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The applicant's definition of "Standard" is controlling. During patent examination, an applicant's claims must be "given their broadest reasonable interpretation *consistent with the specification*." United States Patent & Trademark Office, *Manual of Patent Examining Procedure* § 2111 (8th ed. Rev. 2 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)) (emphasis added) [hereinafter MPEP]. "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach." MPEP § 2111 (citing *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999)).

Moreover, "[a] fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art." See MPEP § 2173.01. "Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim." MPEP § 2106 (citing *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999)).

The Applicant's claimed invention requires "an electronic form having at least one field that is compliant with a *standard*." U.S. Patent Application 09/731,651, claims 1, 12, & 22 (filed Dec. 7, 2000) (amended Aug. 6, 2004) (emphasis added) [hereinafter "Applicant's Disclosure"]. The Applicant has clearly defined the term "standard" to mean "a protocol extension which specifies the fields which may be used in the forms *and* in the corresponding user database." *Id.* at 5 (emphasis added). Each independent

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claim includes this explicit defining terminology. Since the Applicant has provided an explicit definition for the term "standard," that definition controls the interpretation of the term as it is used in the Applicant's claims.

The examiner stated that "Maxwell fails to specifically disclose storing data within a database" but Pennell "discloses storing form filling data in a database." (col. 2:61-col. 3:6). Specifically, Pennell states:

In the described embodiment, the browser automation program 302 may gain knowledge of the format of a form encountered on any number of web sites. For purposes of this invention, a web site for which the format of the form has been learned by the browser automation program 302 is termed a "scripted" site. One method for the browser automation program to gain this knowledge is for the user to have previously filled out the same form. The browser automation program 302 then associates the content and order of the fields for the form with the content of personal data in the user database 304 (e.g., the program 302 learns that the field named "Name" on a particular form should be associated with the user's name in the user database 304.)

Pennell does not disclose a standard compliant database, but rather a program that "learns" about a form appearing on a web site. Such a "learning" type of program is unnecessary with applicant's standard compliant forms and standard compliant database. And since a dependent claim necessarily incorporates all of the limitations of the claim upon which it depends, the prior art *ipso facto* fails to teach all of the limitations in the dependent claims.

In regard to dependent claims 2-9, 11, 13, 15, 16, 18-20, 23-24, and 26-28 and 30, the examiner has not cited references where applicant's dependent claims, when read in light of the "standard" are disclosed.

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3. The examiner has failed to provide substantial evidence of the alleged motivation to modify or combine the teachings of the prior art, which is required to establish *prima facie* obviousness for claims 28 and 30.

Assuming *arguendo* that the prior art cited by the examiner does, in fact, teach all of the limitations in claims 28 and 30, the examiner nonetheless must demonstrate some motivation, suggestion or teaching of the desirability of making specific combinations of prior art to establish obviousness based on a combination of the elements disclosed in the prior art. *Princeton Biochemicals*, 411 F.3d at 1337; *Kotzab*, 217 F.3d at 1370; accord *MPEP* § 2143.01. An alleged suggestion or motivation to modify the teaching of the prior art must be supported by particular findings and substantial evidence. *Kotzab*, 217 F.3d at 1370 & 1371. Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Kotzab*, 217 F.3d at 1369. Broad conclusory statements of suggestion or motivation standing alone are not “evidence.” *Id.* at 1370.

Here, the examiner has provided only broad, conclusory statements regarding the motivation or suggestion to modify Maxwell and Pennell in view of Higley in a manner that would render obvious claims 28 and 30. Specifically, the examiner states that “Maxwell fails to specifically disclose use of Mime protocol,” but Higley does so in column 6:49-67). The examiner further states that “[i]t would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have combined Maxwell and Pennell’s program product with Higley’s program product, since it would have allowed a user to incorporate a standard protocol into data transfer.” The examiner has not provided any particular findings to explain why the combination is proper, nor

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has the examiner identified the *source* for the alleged motivations. *Rouffet*, 149 F.3d at 1356-57; *Fitch*, 972 F.2d at 1266. Accordingly, the examiner's broad statements cannot stand as evidence. Without particular findings, the Board should infer that the examiner "fell into the hindsight trap." *Kotzab*, 217 F.3d at 1371; *Rouffet*, 149 F.3d at 1358.

4. The examiner has impermissibly evaluated the appellant's claims "part by part," using the appellant's claims as a "roadmap to find its prior art components" (claims 1-9, 11-13, 15, 16, 18-20, 22-24, and 26-30)

Finally, the Board should reverse all of the examiner's rejections under § 103 as improper because the examiner has impermissibly evaluated the appellant's claims part by part. Assuming *arguendo* again that the prior art does, in fact, teach all of the limitations in claims 1-13, the prior art nonetheless fails to defeat patentability of the "whole claimed invention." *Kotzab*, 217 F.3d at 1370. The examiner may not evaluate the invention "part by part," using the invention as a "roadmap to find its prior art components." *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). The examiner *must* consider the claimed invention as a whole. *Kotzab*, 217 F.3d at 1369-70; *accord* MPEP § 2141.02.

Here, the examiner appears to be evaluating the appellant's claims word by word, without any consideration or thought to the context of those words – much less the invention as a whole. This tactic clearly is impermissible and should not be condoned by the Board. *See Princeton Biochemicals*, 411 F.3d at 1337.

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VIII. CONCLUSION

With respect to the examiner's rejection of claims 1-9, 11-13, 15, 16, 18-20, 22-24, and 26-30 under § 103, the prior art upon which the examiner relies fails to teach or suggest all of the limitations in the appellant's claimed invention. The examiner has failed to properly identify the source of the motivation, if any, and to explain why the combination of the teachings in the prior art is proper. Without such support, the examiner presumably has engaged in impermissible hindsight reconstruction of the appellant's invention. Accordingly, the examiner's rejections of these claims under § 103 is improper and the Board must reverse these rejections.

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For the foregoing reasons, the appellant submits that the claims of the present application are not fairly taught by any of the references of record, taken either alone or in combination. Therefore, allowance of the present application is in order, and the appellant respectfully requests the Board to reverse the examiner's rejections.



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CLAIMS APPENDIX

The text of the claims involved in the appeal is:

1. A method for inserting data into an electronic form having at least one field that is compliant with a standard, the method comprising:
 - providing a database having at least one field that is compliant with the standard, wherein at least one compliant database field may have a plurality of field values;
 - providing a set of rules that select one field value from each compliant database field having a plurality of field values;
 - applying the set of rules to select one field value from each compliant database field having a plurality of field values;
 - matching each compliant database field with the corresponding compliant form field; and
 - inserting each selected field value into the corresponding compliant form field;
 - wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database; and
 - whereby a completed form is created.
2. The method of claim 1 further comprising the step of:
 - responsive to application of a rule from said set of rules and selection of a field value, changing values in other related fields.
3. The method of claim 1 further comprising receiving the electronic form from a requester.

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4. The method of claim 3 further comprising providing a network as a conduit for receiving the electronic form from the requester.
5. The method of claim 1 further comprising transmitting the completed form across a network.
6. The method of claim 1 further comprising:
 - displaying the plurality of field values in at least one compliant database field having a plurality of field values; and
 - selecting one of the field values so that the selected field value is inserted into the corresponding compliant form field.
7. The method of claim 1 further comprising:
 - providing at least one flag in the electronic form so that the flag determines which field value the rules select from each compliant database field having a plurality of field values.
8. The method of claim 1 wherein the set of rules further resolve conflicts that may arise among field values.

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9. The method of claim 1 further comprising transmitting said the completed electronic form to a requester.

10. (canceled)

11. The method of claim 1 further comprising determining whether each selected field value inserted into the completed form is acceptable.

12. A computer program encoded in a computer-readable medium and operable on a processor to inserting data into an electronic form having at least one field that is compliant with a standard, the computer program comprising:

means for retrieving the electronic form from a network;

means for creating a database having at least one field that is compliant with the standard, wherein at least one compliant database field may have a plurality of field values;

means for creating a set of rules operable to select one field value from each compliant database field having a plurality of field values;

means for applying the set of rules to select one field value from each compliant database field having a plurality of field values;

means for matching each compliant database field with the corresponding compliant form field; and

means for inserting each selected field value into the corresponding complaint form field;

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wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database; and

whereby the computer program product creates a completed form.

13. The computer program of claim 12 further comprising:

means for a user to select a field value from a first compliant database field having a plurality of field values; and

means for changing a field value in a second compliant database field in response to the user selecting a field value for the first compliant database field.

14. (canceled)

15. The computer program of claim 12, wherein the electronic form further comprises at least one flag assigning at least one compliant form field to a first category, and the computer program further comprises:

means for assigning a second category to at least one field value in each compliant database field having a plurality of field values;

means for comparing the first category with the second category; and

if the first category is equivalent to the second category, means for inserting each field value assigned to the second category into each compliant form field assigned to the first category.

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16. The computer program of claim 12 further comprising means for resolving conflicts that arise among field values.

17. (canceled)

18. The computer program of claim 12 further comprising means for transmitting the completed electronic form to a requester.

19. The computer program of claim 12 further comprising:

means for displaying the plurality of field values in at least one compliant database field having a plurality of field values;

means for a user to select one of the field values

means for inserting the selected field value into the corresponding compliant form field; and

means for changing at least one other field value associated with a field of the electronic form.

20. The computer program of claim 12 further comprising means for determining whether each selected field value inserted into the completed form is acceptable.

21. (canceled)

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22. A communication system for filling out an electronic form having at least one field that is compliant with a standard, the communication system comprising:

- a first computer;
- a second computer coupled to the first computer through a communications medium;
- a first storage device coupled to the first computer, the first storage device comprising
 - a database having at least one field that is compliant with the standard, wherein at least one compliant database field may have a plurality of field values, and
 - a set of rules that select one field value from each compliant database field having a plurality of field values;
- a second storage device coupled to the second computer, the second storage device containing the electronic form; and
- a controller coupled to the first storage device operable to
 - transfer the electronic form from the second storage device to the first storage device through the communications medium;
 - apply the set of rules to select one field value from each compliant database field having a plurality of field values;
 - match each compliant database field with the corresponding compliant form field; and
 - insert each selected field value into the corresponding compliant form field;

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wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database; and

whereby a completed electronic form is produced.

23. The communication system of claim 22 further comprising a display device coupled to said controller; wherein the controller is further operable to display the electronic form and at least one field value from each compliant database field having a plurality of field values.

24. The communication system of claim 23 further comprising an input device coupled to said controller and to said display device, the input device operable to select a field value from a first compliant database field having a plurality of field values; and insert the selected field value into the electronic form.

25. (canceled)

26. The communication system of claim 24 wherein the controller is further operable to change at least one field value in a second compliant database field in response to the selection of a field value from the first compliant database field.

27. The communication system of claim 26 wherein the controller is further operable to transfer the completed form from the first storage device to the second storage device through the communications medium.

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28. The computer program of claim 12, wherein the retrieving means is a web browser that connects to the network and retrieves the electronic form from a server using a MIME protocol.

29. The computer program of claim 12, wherein the electronic form further comprises at least one flag assigning at least one compliant form field to a first category, and the computer program further comprises:

means for displaying the plurality of field values in at least one compliant database field having a plurality of field values;

means for a user to select a field value from a first compliant database field having a plurality of field values;

means for changing a field value in a second compliant database field in response to the user selecting a field value in the first compliant database field;

means for assigning a second category to at least one field value in each compliant database field having a plurality of field values;

means for comparing the first category with the second category;

if the first category is equivalent to the second category, means for inserting each field value assigned to the second category into each compliant form field assigned to the first category; and

means for transmitting the completed electronic form to a requester.

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30. The computer program of claim 29, wherein the retrieving means is a web browser that connects to the network and retrieves the electronic form from a server using a MIME protocol.